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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,109	01/14/2004	Steven B. Dunn	MBI-1164	2938
<div>7590 11/09/2009 KNOBLE YOSHIDA & DUNLEAVY, LLC Suite 1350 Eight Penn Center 1628 John F. Kennedy Blvd. Philadelphia, PA 19103</div>				
EXAMINER				
ABBOTT, YVONNE REINIE				
ART UNIT		PAPER NUMBER		
3644				
MAIL DATE		DELIVERY MODE		
11/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/757,109
Filing Date: January 14, 2004
Appellant(s): DUNN ET AL.

John L. Knoble
For Appellant

EXAMINER'S ANSWER

Responsive to the Order Returning Undocketed Appeal to Examiner on 6/25/09, a supplemental Examiner's Answer is set forth below.

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

This is in response to the appeal brief filed 9/17/07 appealing from the Office action mailed 3/9/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 32 and 66 are rejected under 35 U.S.C. 102 (b) as being unpatentable over U.S. Patent 2,273,559 to Burnett.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,273,559	Burnett	2-1942
2,290,886	Lenz	7-1942
5,762,077	Griffiths, Jr.	6-1998
5,897,262	Bratby-Carey	4-1999
5,443,172	Gabriele	8-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 18, 23, 24, 27, 32, 35, 36, 47, 48, 51, 60, 65 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Burnett (2,273,559). Burnett discloses a receptacle containing a powder (10) which is considered to be a styptic material comprising a storage container bottle (5) with a chamber for holding the powder; wherein the interior of concave chamber (6) disk valve (14) and spout or port (13) are considered to be devices for applying the styptic powder; a removable sealing cap or covering means (20) for the storage container, wherein the cap is flush with a side of the container; and a removably attached cross hatched filing device (21) located on an interior side of the container, and has a blunt ended shank portion for attachment to or socket (22) for removably attaching the filing device to the container.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21, 39, 64 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett ('559) in view of Lenz (2,290,886). Although Burnett shows a styptic applicator, it does have a handle. Lenz teaches a styptic pencil having a handle (27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide that the Burnett receptacle have a handle as taught by Lenz to facilitate easy carriage and handling of the device.
5. Claims 11, 30 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett ('559). Although Burnett shows a cross-hatched filing device (21), it is not disclosed that the cross-hatch has a herringbone pattern. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide that the filing device have a herringbone cross-hatch pattern as one of many various cutting/trimming patterns in order to maximize the release of the filed substance to thereby increase the filing effect. Additionally, a herringbone pattern would facilitate ease in gripping the file device. Further, to make the pattern of the Burnett file herringbone is considered to be an obvious design modification lacking disclosed criticality since with respect to a herringbone pattern, Appellant states only that their "filing device 14 can be made of any number of materials including emery board material, metal, sandpaper, etc. In a preferred embodiment the filing device 14 will have a herringbone crosshatch."

6. Claims 1-5, 9-13, 18, 19, 23-27, 29-31, 36, 37, 47-51, and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffiths, Jr. (5,762,077) in view of Burnett ('559). Griffiths, Jr. discloses a manicure device capable of being used to apply styptic to a pet comprising a storage container bottle (12,42) with a chamber for holding a fluid (the chamber is capable of holding styptic); a removable cap or covering means (112,136) for the container, wherein the cap is flush with a side of the container; an applicator device (78,96) for applying the fluid; and a filing device (132,148) which is located on top and bottom sides of the container depending on your orientation and to which file is being referred; wherein the filing device is an emery board and can also come in a variety of textures (col. 7, lines 4-5); wherein the cap(s) comprise a gripping depression (122,142) on a side. Griffiths, Jr., however, do not specifically disclose that the fluid in the chamber is a powder. Both Griffiths, Jr. and Burnett teach vanity receptacles, however Burnett further teaches the use and storage of fluid powder in the receptacle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide that the fluid disclosed in Griffiths, Jr. be a powder styptic depending on the need of the user (e.g. first aid kit, to treat bleeding nails cut or filed too deep). With respect to claims 10-13, 30, 31, and 56-59, Griffiths, Jr. discloses that the filing device comprises emery board and can come in a variety of textures, therefore to provide that the texture has a herring bone cross-hatch, both coarse and fine cross-hatch, or is made of metal or sandpaper would have been obvious to one of ordinary skill in the art since it has been held to be within the

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Additionally, Applicant's description of using different textures lacks disclosed criticality.

7. Claims 1, 2, 5-9, 18, 23, 24, 27, 28, 29, 36, 47, 48, 51-55, 60-62, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bratby-Carey (5,897,262) in view of Burnett ('559). Bratby-Carey discloses a manicure device capable of being used to apply styptic to a pet comprising a storage container bottle (12,28) with a chamber (14,30) for holding a fluid (the chamber is capable of holding styptic); a removable cap or covering means (44) for the container, wherein the cap is flush with a side of the container; an applicator device (22,42) for applying the fluid; and a removably attached filing device (16) which is located on a side portion of the container (12), wherein the filing device is an emery board and it is attached to the container by means of a sticky adhesive coating material. Bratby- Carey, however, do not specifically disclose that the fluid in the chamber is a powder. Both Bratby- Carey and Burnett teach vanity receptacles, however Burnett further teaches the use and storage of fluid powder in the receptacle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide that the fluid used in one of the chambers disclosed in Bratby- Carey be a powder styptic depending on the need of the user (e.g. first aid kit, to treat bleeding nails cut or filed too deep). With respect to claims 6, 8, 52, 54, 61, 62, 68 and 69, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to use snap or hook and loop mechanisms as the means of attaching the emery board to the Bratby-Carey container as alternative equivalent fastening means to the sticky adhesive. Bratby-Carey further discloses that the emery board is secured by the sticky adhesive, "is replaceable and can be removed" (col. 3, lines 5-12). Motivation for using alternate attachment mechanisms on the Bratby-Carey receptacle can be found since Applicant also discloses (specification, page 6) that the purpose of the snap and hook and loop mechanisms is to allow their filing device to be "removable from the styptic applicator, it can then be replaced when it has been worn down".

8. Claims 20 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bratby-Carey ('262) in view of Burnett ('559) as applied to claims 1 and 23 and further in view of Gabriele (5,443,172). Although Bratby-Carey disclose a manicure device comprising a receptacle having a removable cap, it is not disclosed that the cap comprises a gripping surface made of elastomeric material for improved gripping. Gabriele teaches a non-slip closure grip for a receptacle wherein to use the non-slip closure grip (10), a person simply can tighten and loosen the cap member (18) on the upper portion (14) of the receptacle (12) by engaging the fingers with the elastomeric band (36). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the elastomeric grip of Gabriele on the cap of Bratby-Carey as taught by Gabriele that the elastomeric band (36) has a gripping

surface to make opening and closing of the cap member (18) easier, by significantly reducing the strength required to do this.

(10) Response to Argument

Rejections under 35 U.S.C. 102

With respect to the application of the Burnett ('559) reference, Appellants argue that Burnett fails to disclose that the receptacle has any utility at all for use with pet, that it could be used for dispensing or applying styptic material, that it contains a styptic, and that the Burnett article includes an applicator. The Examiner refutes this argument since Burnett clearly shows a chamber for holding a powder (10), which is well known to be used as a clotting or styptic material, and the interior of concave chamber (6) disk valve (14), and spout or port (13) are considered to be applicators capable of applying or dispensing the styptic powder, thus meeting the limitations of Appellants' independent claims 1 and 65. As for the device being used for a pet, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Appellants further state that the limitation in claims 5, 27 and 51 of a filing device having an attachment member for being removably attached to the container is clearly not disclosed by Burnett, however, it should be noted that the shank end of the file is considered to meet this limitation. Appellants state that the cap is not flush with a side of the container as stated in claims 18 and 36, however, Figure 4, does

show that covering means or cap (20) is indeed flush with a side; also the cap is shown (Figure 5) to be removable as required by claim 60. Appellants argue that there is "no spout of any type disclosed in the Burnett reference" (Appellant's Brief, page 10), however, discharge port (13) provides a tube through which the powder is dispensed, and without further structural definition by Appellants, this is considered to meet the claim limitation thus meeting the limitations of Appellants' independent claim 66.

Rejections under 35 U.S.C. 103

Appellants state that the Lenz ('886) reference fails to disclose the provision of a handle on the removable cap as recited in claims 21, 39, 64 and 67. This statement is refuted in that Lenz shows that cap (25) does have a handle (27) connected thereto. It is reiterated that the Burnett ('559) reference discloses an apparatus for applying powder, which is a styptic material. Further, to modify Burnett by adding a handle as taught by Lenz would have been obvious to facilitate easy carriage and handling of the article.

The Griffiths, Jr. reference discloses a device comprising a storage container (12,42) for holding fluid (which is capable of holding styptic). With respect to the application of the Griffiths, Jr. ('077) reference, Appellants assert that this reference discloses an apparatus for manicuring nails that includes a chamber for containing nail polish, but there is no disclosure of a styptic material, and that the apparatus is not for grooming pets since it is for human fingernails. Firstly, it should be noted that it is known to polish pet paws (nails) with polish, and further there is no limitation in

Griffiths, Jr. as being strictly for human application. As to claims 2, 24, 25, 26 and 48-50 requiring that the filing device being located on a side, it is maintained that Griffiths, Jr. shows filing devices (132,148) located on top (claim 4 limitation) and bottom (claim 25) sides of the article. The attachment member of the filing device is removably attached to the container by means of the threaded engagement of caps (112,136) with the container. Appellants argue that Griffiths, Jr. does not disclose that the filing device is made of "Emory board material", however, attention should be directed to column 7, lines 4-5 of Griffiths, Jr. which states that emery board is adhered to the file member. Since it is presumed that Appellant misspelled "emery" and indeed meant to refer to "emery" (the granular substance typically used on nail files), Griffiths, Jr. meets the claimed limitation. Appellant states that the incorporation of the file of Burnett into the Griffiths, Jr. reference would render it unusable, however, it should be noted that Burnett was applied to Griffiths, Jr. solely to teach that the fluid is powder styptic (i.e. nothing about the Griffiths, Jr. file is modified). With respect to claims 11- 13, 29-31, and 55-59 reciting the course and fine herringbone cross-hatch, metal and sandpaper textures, Griffiths, Jr. discloses that the emery board can come in a variety of textures. Therefore, the herringbone cross-hatch (course or fine), metal, or sandpaper would have been obvious as one of many various cutting/ trimming patterns in order to maximize the release of the filed substance to thereby increase the filing effect. Additionally, contrary to Appellants' arguments regarding claims 18, 19, 36 and 37,

Figure 1 of Griffiths, Jr. shows the caps being flush with a side of the container, and the gripping depressions are elements (122 and 142).

Regarding the application of the Bratby-Carey ('262) reference, Appellants reiterate their argument of no disclosure of styptic material, and the intended use of their invention for grooming pets as distinguishing features. Bratby-Carey teach a device comprising a storage container (12, 28) for holding fluid (which is capable of holding styptic). Again, it should be noted that it is known to polish pet paws (nails) with polish, and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). With respect to the styptic material, Burnett was added to teach the obviousness of powder as the fluid in the Bratby-Carey applicator, especially since it is well known to apply powder (such as acrylic) to nails. Appellants argue with respect to claims 2, 24 and 48, that Bratby-Carey does not disclose a filing device on a side of the container; however, this is clearly shown in Figure 1. With respect to claim 55, Appellants argue that Bratby-Carey does not disclose that the filing device is made of "Emory board material"; however, attention should be directed to column 3, lines 4-10 of Bratby-Carey which states that emery board is adhered to the file member. The emery board filing device (16) is further disclosed as being attached by means of an adhesive coating. It is reiterated that since Bratby-Carey discloses that the filing device is secured by the adhesive so that it

"is replaceable and can be removed" (col. 3, lines 5-12), the motivation for using the alternate attachment mechanisms of claims 6,8,52,54,61,62,68 and 69 can be found Appellants' own Specification (page 6) which states that the purpose of the alternate mechanisms is to allow the filing device to be removable from the applicator and replaced. Contrary to Appellants' assertion regarding claims 18 and 36, the cap (44) is shown to be flush with a side of the container (Figure 1); and the cap is shown to be removable as required by claim 60. Bratby-Carey was not applied to claim 19 as implied by Appellants' Brief (page 25), so it is not clear to what Appellants are referring. As to claim 29, Burnett was added solely to teach a file made of metal material, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the Bratby-Carey file of a metal material to provide a more durable structure.

The Gabriele ('172) reference was applied to teach the obviousness of constructing the gripping surface of the cap of an elastomeric material. Gabriele discloses a removable cap having an elastomeric non-slip gripping surface (10) so that a person can tighten and loosen the cap member (18) more easily and without finger or hand slippage thereby reducing the strength required to turn the cap. Appellants argue that the Gabrielle cap for jar lids has nothing to do with grooming products for animals or humans, and therefore constitutes nonanalogous prior art. In response to applicant's argument that Gabrielle cap is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the elastomeric cap of Gabriele is reasonably pertinent to the particular problem (of providing a gripping surface on a removable cap) with which Appellant is concerned as stated in Appellants' Specification, page 5, lines 1-2, "the cap 28 can have an elastomeric material to make grasping it easier". As for Appellants' field of endeavor, caps or lids are absolutely used in the field of animal husbandry, and the receptacle cap or lid of Gabriele could easily be used on a container which houses pet shampoo, medicant or food. Since the Bratby-Carey and Burnett references also disclose removable caps, it is maintained that their modification using the Gabrielle reference is appropriate.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) subparagraph (5) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Yvonne R. Abbott/

Primary Examiner, Art Unit 3644

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Katherine Matecki/

Kathy Matecki
Director, TC 3600

Conferees:

Robert Swiatek /RPS/

Meredith Petravick / mcp/